



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/815,533 | 03/16/2001 | Achille Arini | 515-4218 | 9691 |

7590 06/02/2003

James V. Costigan, Esq.
HEDMAN & COSTIGAN, P.C.
Suite 2003
1185 Avenue of the Americas
New York, NY 10036-2646

EXAMINER

STEADMAN, DAVID J

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/02/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/815,533

Applicant(s)

ARINI ET AL.

Examiner

David J. Steadman

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 69-80.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Art Unit: 1652

ADVISORY ACTION

[1] Status of the claims:

- Claims 69-80 are pending in the application.
- Claims 69-80 stand finally rejected.

[2] Receipt of a notice of appeal filed as Paper No. 15, May 15, 2003, is acknowledged.

[3] The request for reconsideration in the after final amendment of Paper No. 16, filed May 15, 2003, is acknowledged. The amendment would appear to overcome some of the objections and/or rejections previously set forth in the Office action of Paper No. 14. However, the amendment does not place the claims in condition for allowance because the amendment would require further consideration of the claims and a new search. Regarding a new search, applicant has limited the claims to a process wherein at least 95% of the total urokinase is catalytically active tc-uPA. As this limitation was not previously presented in the claims, a new search would be required. See MPEP 714.13 regarding non-entry of after final amendments.

[4] Applicant's arguments in the after final amendment of Paper No. 16 are acknowledged. However, in view of the non-entry of the amendment, the objections and rejections as set forth in the Office action of Paper No. 14 are maintained for the reasons of record. The amendment would appear to overcome the objections of items 3-5 of Paper No. 14 and the rejections of items 6-11 of Paper No. 14.

[5] It is noted that even if the amendment of Paper No. 16 were entered, claims 91 and 92 are drawn to the non-elected invention of Groups II and III as set forth in the Office action of Paper No. 8 and would not be co-examined with the elected invention of Group I.


[6] It is further noted that the amendment to the specification would not overcome the sequence compliance requirement as set forth in item 2 of Paper No. 14. The amendment to the specification to identify the peptide sequences as "seq IDN3" and "seq IDN4" is improper. Proper sequence identifiers such as "SEQ ID NO:3" and "SEQ ID NO:4" should be used to identify the peptide sequences. See MPEP § 2422. To be in compliance, applicants must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper copy of the "Sequence Listing", as well as an amendment directing its

Art Unit: 1652

entry into the specification, and a statement that the content of the paper and CRF copies are the same and, where applicable, include no new matter as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.821(b) or 1.825(d).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Thursday from 6:30 am to 5:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.
Patent Examiner
Art Unit 1652


REBECCA E. PROUTY
PRIMARY EXAMINER
~~GROUP 1000~~
1600